

REMARKS

Claims 1–10, 14, 15, 19, 20, 24, 25, and 29 are pending, in which claims 1–6 were withdrawn from examination on the merits on account of the Election of Species Requirement dated February 28, 2002. No amendment has been made.

Rejections under 35 U.S.C. § 102 over Murakami

Claims 7-10, 15, 20, and 25 are rejected under 35 U.S.C. § 102 as allegedly being anticipated by Murakami et al (U.S. Patent No. 4,264,667). Applicants respectfully traverse the rejections.

The Office Action contends that film properties recited in the present claims, including a shrinkage of about 10% to about 40% along its main shrinkage direction in water of 70°C for 5 seconds, a shrinkage of about 50% or more along its main shrinkage direction in water of 95°C for 5 seconds, a shrinkage of about 10% or less along a direction perpendicular to its main shrinkage direction in water of 95°C for 5 seconds, and an adhesive retention of about 95% or more after shrinkage, are inherent to the file disclosed by Murakami et al. Applicants disagree.

The declaration under 37 C.F.R. 1.132 submitted on July 5, 2007 has provided data showing that a film made according to Example 3 of Murakami et al does not have the heat shrinkage and adhesive retention properties as recited in independent claims 7, 15, 20, and 25 or the film haze property as recited in independent claim 15. The Office Action contends that the declaration is unpersuasive because Murakami et al is not limited to the examples and the shrinkage of the claimed film are disclosed by Murakami et al because the composition and drawing conditions of the claimed film are disclosed by Murakami et al. Applicants respectfully point out that in order to establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). See MPEP 2112

IV. Applicants have established that at least one film disclosed in Murakami et al does not have the properties as recited in the present claims, and therefore **met their burden of proof** that the films disclose in Murakami et al **do not necessarily** have the properties as recited in the present claims. Murakami et al discloses at most a broad range of films. The heat shrinkage and adhesive retention properties recited in the present claims are not necessarily present in the films of Murakami et al, but result from optimization of conditions. The fact that certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). See MPEP 2112 IV.

Additionally, none of the heat shrinkage and adhesive retention properties as recited in the claims is taught or suggested by Murakami et al. Applicants submit that the term “shrinkage” in col. 7, l. 56 of Murakami et al is merely a translation error for “relaxation.” It would have been obvious to one of ordinary skill in the art, even without reading the original Japanese document, that the “shrunk” state recited in col. 7, ll. 53-58 of Murakami et al refers to the relaxed state of film during the heat treatment step of the film manufacturing process. Specifically, one of ordinary skill in the art would have understood the “shrinkage” of within 50% to mean a relaxation rate of within 50%. Such a relaxation rate is associated with the relaxed state of film during its manufacturing process, and is completely different from the heat shrinkage rate, which is a property of the finished film product.

For at least the reasons stated above, Murakami does not teach, expressly or inherently, all the limitations as recited in the present claims. Withdrawal of the rejections is respectfully requested.

Rejections under 35 U.S.C. § 103(a) over Murakami in view of Yoshinaka

Claims 14, 19, 24, and 29 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Murakami et al in view of Yoshinaka et al (U.S. Patent No. 4,996,291). Applicants respectfully traverse the rejections.

As stated above, Murakami et al does not teach, expressly or inherently, all the limitations as recited in the present claims. The deficiency is not cured by Yoshinaka et al

because Yoshinaka et al does not teach the heat shrinkage or adhesive retention properties recited in the claims either.

For at least the reasons stated above, Murakami, Yoshinaka, or the combination thereof does not teach, expressly or inherently, all the limitations as recited in instant claims. A *prima facie* case of obviousness has not been established. Withdrawal of the rejections is respectfully requested.

CONCLUSION

Applicants submit that the claims are allowable and an early and favorable action to that effect is respectfully requested.


The Examiner is invited to contact the undersigned to discuss any issues regarding this application.

In the event that the filing of this paper is deemed not timely, applicants petition for an appropriate extension of time. The Office is authorized to charge any underpayment or credit any overpayment to Kenyon & Kenyon LLP's Deposit Account No. 11-0600.

Respectfully submitted,

Date: February 5, 2008

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